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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,229	04/20/2000	ROLF BRANDENBERGER	08846-076001	8809

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[REDACTED] EXAMINER

SINGH, SUNIL

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3673

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/508,229

Applicant(s)
Brandenberger et al.

Examiner
Sunil Singh

Art Unit
3673

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Feb 26, 2003

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-8, 10-17, and 21-26 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-8, 10-17, 23, 25, and 26 is/are rejected.

7) Claim(s) 21, 22, and 24 is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) Other: _____

DETAILED ACTION

Applicant should disregard office action mailed 3/11/03 and respond to this office action.

Specification

1. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- (C) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (I) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

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Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 4, 6, 16 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admission of prior art (see page 1 lines 10-31 and page 2 lines 1-5, of applicant's specification).

Applicant admits it is known to have a cladding on a partially-overhanging substrate which comprises, in sequence starting from the substrate; a drainage means, wherein the drainage means is a plastics mesh with at least a partial waterproof layer; a waterproofing membrane and a layer of concrete. The waterproofing membrane is a plastics material. A fastening means used to secure said waterproofing membrane to said drainage means (see page 2 lines 1-5 of applicant's specification).

It should be noted, that it has been held that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. Additionally, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious

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from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) {see MPEP 2113}.

In this case “a waterproofing membrane which has been applied thereto by spraying” is considered a process limitation in a product claim. Since process limitations are of no consequence in a product claim as long as all of the definite structural limitations are met (either by the claimed process or another) the process limitation is not given patentable weight. Clearly, the definite structure of “a waterproofing membrane” is disclosed as being well known and the process of applying the waterproofing membrane is inconsequential.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 7, 8, 11-15, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant’s admission of prior art (see page 1 lines 10-31 and page 2 lines 1-5, of applicant’s specification) in view of Wipo document (98/24738)

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Applicant's admission of prior art discloses the invention substantially as claimed.

However, Applicant's admission of prior art is silent about the waterproofing membrane being sprayed plastics material, layer of coalesced particles of thermoplastic polymer and the layer of concrete being sprayed and containing reinforcing fibers. Wipo document '738 teaches a sprayed waterproofing membrane such as plastics material, a layer of coalesced particles of thermoplastic polymer and a sprayed layer of concrete containing reinforcing fibers (see abstract and pages 4-5). It would have been considered obvious to one of ordinary skill in the art to modify what applicant admits as prior art by substituting the waterproofing means and concrete means as taught by Wipo '738 for the waterproofing means and concrete means disclosed by applicant as prior art since it is a design choice to substitute equivalent parts for performing equivalent functions. Such a substitution would reduce the time of construction of the cladding.

In the event applicant does not agree that “applied thereto by spraying” is not a product by process claim, the following rejections below then apply.

6. Claims 1-3, 8, 10, 11, 16, 17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art (see page 1 lines 10-31 and page 2 lines 1-5, of applicant's specification) in view of Pulkkinen '188.

Applicant admits it is known to have a cladding on a partially-overhanging substrate which comprises, in sequence starting from the substrate; a drainage means, wherein the drainage means

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is a plastics mesh with at least a partial waterproof layer; a waterproofing membrane and a layer of concrete. The waterproofing membrane is a plastics material. A fastening means used to secure said waterproofing membrane to said drainage means (see page 1 line 29 and page 2 lines 1-5 of applicant's specification). Applicant's admission of prior discloses the invention substantially as claimed. However, applicant's admission of prior art lacks a waterproofing membrane which has been applied thereto by spraying and an initial layer of concrete between the drainage means and the substrate. Pulkkinen teaches a waterproofing membrane which has been applied thereto by spraying (see col. 3 line 3+) and an initial layer of concrete (13) between drainage means (15) and the substrate. It would have been considered obvious to one of ordinary skill in the art to modify applicant's admission of prior art by substituting the sprayable waterproofing membrane as taught by Pulkkinen for the waterproofing membrane disclosed by applicant as prior art and to further include the initial layer of concrete as taught by Pulkkinen since this would more effectively prevent leakage since there is no fastening means such as nails etc. used to install the waterproofing membrane and to provide a surface wherein the drainage means could be uniformly attached thereto.

With regards to claims 8,10,11 and 17, the recited method steps are considered to be obvious in view of the combination as described above.

7. Claims 1, 3-8, 11-17, 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art (see page 1 lines 10-31 and page 2 lines 1-5, of applicant's specification) in view of Wipo '738.

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Applicant admits it is known to have a cladding on a partially-overhanging substrate which comprises, in sequence starting from the substrate; a drainage means, wherein the drainage means is a plastics mesh with at least a partial waterproof layer; a waterproofing membrane and a layer of concrete. The waterproofing membrane is a plastics material. A fastening means used to secure said waterproofing membrane to said drainage means (see page 1 line 29 and page 2 lines 1-5 of applicant's specification). Applicant's admission of prior discloses the invention substantially as claimed. However, Applicant's admission of prior art is silent about the waterproofing membrane being sprayed plastics material, layer of coalesced particles of thermoplastic polymer and the layer of concrete being sprayed and containing reinforcing fibers. Wipo document '738 teaches a sprayed waterproofing membrane such as plastics material, a layer of coalesced particles of thermoplastic polymer and a sprayed layer of concrete containing reinforcing fibers (see abstract and pages 4-5). It would have been considered obvious to one of ordinary skill in the art to modify what applicant admits as prior art by substituting the waterproofing means and concrete means as taught by Wipo '738 for the waterproofing means and concrete means disclosed by applicant as prior art since it is a design choice to substitute equivalent parts for performing equivalent functions. Such a substitution would reduce the time of construction of the cladding.

With regards to claims 8, 11-15 and 17, the recited method steps are considered to be obvious in view of the combination described above.

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8. Claims 1-3, 6-8, 10-11, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulkkinen '188 in view of applicant's admission of prior art (see page 1 lines 10-31 and page 2 lines 1-5, of applicant's specification).

Pulkkinen discloses a cladding on a partially-overhanging substrate (14) which comprises, in sequence starting from the substrate; a drainage means (15); a waterproofing membrane (12) which has been applied thereto by spraying and a layer of reinforcing (fibre) concrete (11). The substrate is given an initial layer of concrete 13). Pulkkinen discloses the invention substantially as claimed. However, Pulkkinen lacks a drainage means that is a plastics mesh with at least a partial waterproof layer. Applicant admits that a drainage means that is a plastics mesh with at least a partial waterproof layer is old and well known (see applicant's admission of prior art page 1 lines 10-32 of applicant's specification). It would have been considered obvious to one of ordinary skill in the art to modify Pulkkinen by substituting the drainage means as taught by applicant as known prior art for the drainage means disclosed by Pulkkinen since it is a design choice to substitute equivalent parts for performing equivalent functions. Such a substitution would provide a more effective waterproofing system.

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pulkkinen '188 in view of Wipo document (98/24738).

Pulkkinen discloses the invention substantially as claimed. However, Pulkkinen lacks a waterproofing membrane being a layer of coalesced particles of thermoplastic polymer.

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Wipo document '738 teaches a waterproofing membrane being a layer of coalesced particles of thermoplastic polymer and a layer of concrete containing reinforcing fibers (see abstract and pages 4-5). It would have been considered obvious to one of ordinary skill in the art to modify Pulkkinen by substituting the waterproofing means as taught by Wipo '738 for the waterproofing means disclosed by Pulkkinen since it is a design choice to substitute equivalent parts for performing equivalent functions. Such a substitution would allow for the layer of concrete to make a more effective bonding with the waterproofing membrane.

10. Claims 4-5, 12-14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulkkinen as modified by applicant's admission of prior art as applied to claims 1 and 8 above, and further in view of Wipo document (98/24738).

Pulkkinen (as modified by applicant's admission of prior art) discloses the invention substantially as claimed. However, Pulkkinen (as modified by applicant's admission of prior art) lacks sprayed waterproofing membrane such as plastics material, a layer of coalesced particles of thermoplastic polymer and wherein the layer of concrete is sprayed reinforcing fiber concrete. Wipo document '738 teaches sprayed waterproofing membrane such as plastics material, a layer of coalesced particles of thermoplastic polymer and a layer of concrete being sprayed reinforcing fiber concrete (see abstract and pages 4-5). It would have been considered obvious to one of ordinary skill in the art to further modify Pulkkinen (as modified by applicant's admission of prior art) by substituting the waterproofing means and concrete means as taught by Wipo '738 for the waterproofing means and concrete means disclosed by Pulkkinen (as modified by applicant's

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admission of prior art) since it is a design choice to substitute equivalent parts for performing equivalent functions. Such a substitution would allow for the layer of concrete to make a more effective bonding with the waterproofing membrane.

Response to Arguments

11. Applicant's arguments with respect to claims 1 and 8 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

12. Claims 21-22 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Sunil Singh

Patent Examiner

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4/21/03



HEATHER SHACKELFORD
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